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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER EVANISKO, LESLIE J	
			ART UNIT 2854	PAPER NUMBER ..
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/548,314

Applicant(s)

FABER, ERNST

Examiner

Leslie J. Evanisko

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2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-17 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 4) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1-15 are objected to because of the following informalities:

With respect to claim 1, it is suggested that the term "the ink pad" in line 11 be deleted and replaced with --an ink pad-- since no ink pad was previously recited in the claim.

With respect to claim 11, the claim has two periods (lines 5 and 7) and it appears that the last two lines of the claim should be deleted since they are redundant of the language in lines 4-5.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Pichler et al. (WO 01/85462). Since WO 01/85462 is not in the English language, note the examiner has relied upon the corresponding equivalent U.S. Patent 6,797,230 B2 which is in the English language for the specific nature of what Pichler et al. teaches in

the PCT document. Therefore, the specific references to columns and lines of Pichler et al. set forth in the rejection below are with respect to the corresponding US Patent document.

Pichler et al. teach a self-inking stamp with upper inking, comprising a housing 1 in which a stamp unit which is coupled with an actuating part 6 and includes stamp characters is movably arranged and which has an insertion compartment 8 with at least one insertion opening for an ink pad container 3, the insertion compartment having an opening at its lower side facing the stamp unit for inking of the stamp characters, when the stamp characters are in their upper, turned position, by contacting the ink pad in the ink pad container, wherein guiding and centering projections 9 are provided for the ink pad container which are arranged on two opposite sides of the insertion compartment in the direction of insertion, and wherein the ink pad container 3 has recesses 7 cooperating with the guiding and centering projections as shown in Figure 2. See Figures 1-5 and column 2, lines 12-19 of Pichler et al.

With respect to claim 2, Pichler et al. teach the guiding and centering projections 9 are formed by ledges extending in the direction of insertion.

With respect to claim 4, Pichler et al. teach the ink pad container broadly has a lower rim, which is provided on lower side portions of the ink pad container when inserted in the insertion compartment.

4. Claims 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Skopek (AT 383 993 B). Skopek teaches an ink pad container 31 comprising a bottom and walls projecting away therefrom, wherein lateral recesses are provided on a rim of the two

opposite side walls that faces away from the bottom. See, in particular, Figure 2 of Skopek.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pichler et al. (WO 01/85462). Pichler et al. teach a self-inking stamp as recited with the exception of the ledges being substantially rectangular as seen in front view. However, it has been held that changes in shape of structure was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed structure was significant. Particular attention is invited to MPEP 2144.04(IV)(B) and In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Thus, it would have been obvious to one ordinary skill in the art to provide the ledges of Pichler et al. to be substantially rectangular in shape as it simply comprises an obvious matter of design choice and the stamp would appear to be perform equally well with rectangular ledges.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4 and 7-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 8-9 and 17 of copending Application No. 10/548745 in view of Pichler et al. (WO 01/85462).

With respect to claims 1, 2, and 4, Claim 1 of US ‘745 teach a self inking stamp having an insertion compartment and ink pad container as recited with the exception of the guiding and centering projections being provided on opposite sides of the insertion compartment cooperating with recesses on the ink pad container. However, Pichler et al. teach providing guiding and centering projections formed by ledges extending in the direction of insertion provided on opposite sides of the insertion compartment of a self-inking stamp and cooperating with recesses on the ink pad container is well known in the art. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the self inking stamp of claim 1 of US ‘745 with the guiding and

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centering projections of Pichler et al. to provide for smoother insertion of the ink pad container into the stamp.

With respect to claim 3, Claim 1 in view of Pichler et al. teach the self-inking stamp as recited with the exception of the ledges being substantially rectangular as recited. Again, note that it has been held that changes in shape of structure was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed structure was significant. Particular attention is invited to MPEP 2144.04(IV)(B) and In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Thus, it would have been obvious to one ordinary skill in the art to provide the ledges of Claim 1 as modified by Pichler et al. to be substantially rectangular in shape as it simply comprises an obvious matter of design choice and the stamp would appear to be perform equally well with rectangular ledges.

With respect to claims 7, 11, 12, and 13, note claim 1 of US '745.

With respect to claim 8, note claim 2 of US '745.

With respect to claim 9, note claim 3 of US '745.

With respect to claim 10, note claim 4 of US '745.

With respect to claim 14, note claim 8 of US '745.

With respect to claim 15, note claim 9 of US '745.

This is a provisional obviousness-type double patenting rejection.

9. Claims 16-17 and 19-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/548745 in view of Skopek (AT 383 993 B).

With respect to claims 16-17, Claim 17 of US '745 teach an ink pad container as recited with the exception of the lateral recesses being provided on two opposite side walls of the ink pad container for cooperating with guiding and centering projections in the insertion compartment. Skopek teaches providing lateral recesses on a rim of two opposite side walls of an ink pad container is well known in the art. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide lateral recesses on the side walls of the ink pad container of claim 17 of US '745 to allow for smoother insertion of the ink pad container into the stamp.

With respect to claims 19-22, note claim 17 of US '745.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

10. Claims 5-6 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 5 in particular, the prior art of record fails to teach or fairly suggest a self-inking stamp having all of the structure as recited in combination with and particularly including an ink pad container in which the recesses cooperating with

the guiding and centering projections are provided on the lower rim of the ink pad container.

With respect to claims 6 and 18 in particular, the prior art of record fails to teach or fairly suggest an ink pad container having all of the structure as recited, in combination with and including the recesses on their side which is the upper side in the inserted state being delimited by ledge projections on side walls of the ink pad container.

Response to Arguments

12. Applicant's arguments filed April 19, 2007 with respect to claims 1-4 have been fully considered but they are not persuasive of any error in the above rejection.

In response to applicant's argument that the references (particularly, Pichler et al.) fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the guiding and centering projections being located on the two **lateral** opposite sides of the compartment) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note that claim 1 just broadly recites two opposite sides of the compartment, which is clearly met by Pichler et al. Regardless, the term lateral is defined by the American Heritage Dictionary as "Of, relating to, or situated at or on the side" and the projections and the projections of Pichler et al. can broadly be considered to be situated at opposite sides (i.e., right and left) of the compartment.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leslie J. Evanisko /
Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
August 16, 2007